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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/630,552  | 08/01/2000  | Yutaka Nakamura      | 101136-00013        | 6674             |
| 7590 07/21/2004   |             |                      | EXAMINER            |                  |
| Arent Fox Kintner Plotkin & Kahn<br>1050 Connecticut Avenue NW Suite 600<br>Washington, DC 20036-5339 |             |                      | LUU, THANH X        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2878                |                  |

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/630,552             | NAKAMURA, YUTAKA    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Thanh X Luu            | 2878                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2004 has been entered.

Claims 1-3 are currently pending.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 2, it is unclear in its given context what the phrase "without scanning an entire distance range for focusing" refers to. That is, what element is not scanned in an entire distance range? If in fact Applicant is referring to the lens that is not scanned an entire distance range, it is unclear how the lens is not scanned an entire distance range if the lens moves "from one end toward an opposite end of a movable range."

Regarding claim 3, it is unclear in its given context what the phrase "without

scanning an entire distance range for focusing” refers to. That is, what element is not scanned in an entire distance range?

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kumagai et al. (U.S. Patent 5,742,378).

Regarding claims 1-3, Kumagai et al. disclose (see Figure 13) an automatic focusing mechanism having a telescope for sighting a leveling rod (see Figure 2) with pattern marks at an equal pitch between each mark, and a photoelectric device (15) for converting an image sighted by the telescope into an electric signal with a set range to automatically adjust a focus on the rod, the mechanism comprising: driving means (17) for moving a focusing lens (112) of the telescope from one end toward an opposite end of a movable range of the focusing lens; pitch computing means (15 and 166; see also Figures 12 and 14) for obtaining only the pitch of the pattern marks as claimed to obtain a distance (see column 4, lines 20-25) based only on the pitch; and fine adjusting means (see column 14, lines 10-15) for moving the focusing lens to a position corresponding to the distance. That is, since the focusing lens is moved to a focused position, the position of the lens corresponds to the distance. Furthermore, Kumagai et al. disclose one end is a position corresponding to an infinite distance and wherein the

lens is driven toward an objective lens to obtain the pitch (see col. 11, lines 60-62 and col. 12, lines 15-25). Furthermore, the focusing lens is not moved in the entire distance range (see Fig. 15), since the lens is stopped when a peak is detected and moved in the opposite direction and then is further stopped.

### ***Response to Arguments***

6. Applicant's arguments filed April 7, 2004 have been fully considered but they are not persuasive.

First, Applicant asserts that the present invention has the advantage that focusing on a leveling rod can be performed without large modification to a conventional measuring device. However, since such language is not found in the claims, Applicant's assertion is irrelevant.

Applicant also asserts that the prior art does not disclose moving the lens based on the distance. Such language is not found in the claims. Applicant simply claims moving the lens to a position corresponding to the distance. As understood, since the lens is moved to a focused position, and the focused position corresponds to the distance, such a limitation is disclosed.

Applicant further asserts that the prior art does not disclose a fine adjusting means. Examiner disagrees. Applicant's fine adjusting means is simply a stepping motor. As understood, since the prior art discloses an equivalent motor (arc motor or an ultrasonic motor), the limitation is met.

In addition, Applicant asserts that the lens is inherently driven towards the objective lens to sense the presence of the rod. Examiner reminds Applicant that only

explicitly claimed features of the invention are examined. Since the claims do not state what is inherent in the invention and lacks such language, Applicant's assertions about inherent features are irrelevant.

Also, Applicant asserts that the invention does not scan the whole range, which the prior art lacks. Examiner disagrees. As shown in Fig. 15, since the lens is stopped and is moved in the opposite direction, as understood, the lens does not move in the entire range as claimed.

Thus, as set forth above, this rejection is proper.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh X Luu whose telephone number is (571) 272-2441. The examiner can normally be reached on M-F (6:30-4:00) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Thanh X. Luu', with a long horizontal flourish extending to the right.

Thanh X. Luu  
Primary Examiner  
Art Unit 2878

07/2004